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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,238	04/01/2004	Joseph M. Asher	04-6193 (069547.0193)	9139
63710 7590 03/05/2009 DEAN P. ALDERUCCI CANTOR FITZGERALD, L.P. 110 EAST 59TH STREET (6TH FLOOR) NEW YORK, NY 10022				
EXAMINER				
POND, ROBERT M				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
03/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,238

Applicant(s)

ASHER ET AL.

Examiner

Robert M. Pond

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/31/08; 9/11/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18, 20 and 38-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18, 20 and 38-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statements(s) (PTO/SB/08)
- 4) ☒ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 11/16/07.
- Paper No(s)/Mail Date: 20090225.

DETAILED ACTION

Withdrawal of Finality on Appeal

The finality of the final action on Appeal is withdrawn. All pending claims 11-18, 20, 38-64 were examined in this non-final office action necessitated by new grounds of rejection.

In view of the Appeal Brief filed October 31, 2008 filed on, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Jeffrey A. Smith/

Supervisory Patent Examiner, Art Unit 3625

Response to Arguments

Applicant's arguments with respect to claims 11, 41, and 53 and all pending dependent claims have been considered but are moot in view of the new ground(s) of rejection. An examination of the pending claims on their merit is not provided due to the inoperative nature of the current independent claims. The Examiner is willing to continue discussions with Applicants' counsel to work through the issues cited below.

Claim Rejections - 35 USC § 112

- 1. Claims 11, 41 and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants are entitled to incorporate subject matter of claims 35 and 36 originally filed to correct this problem. This clarifies the embodiment for tiered system of time increments disclosed for Step 285 of Figure 2.

Supporting Evidence

Applicants' Appeal Brief identifies page 21, lines 3-11 of the instant specification as evidence of support for the following in Claim 11 for example:

"determining that the period of time has expired based on determining that:

- 1) a first quantity of bids that is received before a first time interval is less than a first pre-determined value; and
- 2) a second quantity of bids that is received before a second time interval is less than a second pre-determined value; and"

The supporting disclosure describes one of several embodiments applied to Step 285 of Figure 2. No other figures are provided by the Applicants to shed light on how the various embodiments within Step 285 would be applied within the context of Figure 2. The supporting disclosure for the above claimed subject matter from page 21, lines 3-10 reads:

"In another embodiment, the determination of the end of bidding may be according to a tiered system that processes the received number of bids based upon one of a number of time increments. For example, the bidding may be ended if network device 106 receives five or less bids during the first twenty minutes, four or less bids during the next twenty minutes, and three or less bids during any twenty minute range beyond that."

Clarifications of the following terms will be useful to further develop the Examiner's position:

- Predetermined time: a time at which the auction engine ends the auction. See at least 0030; Fig. 2 (285) and 0039.
- Predetermined amount of time: auction engine ends the auction when bidding appears to have stopped in that no new bids have been received for a pre-determined amount of time. See at least 0030.
- Predetermined criteria: predetermined criteria is used to determine a winning bid. See at least 0003; 0004; 0005. Originally filed claim 9 (canceled) discloses predetermined criteria as the highest bid on the item within a predetermined time after the beginning of the auction. OR, originally filed claim 10 (canceled) discloses predetermined criteria as the highest bid after determining that no new bids have been received for a predetermined amount of time. OR, auction engine may end the auction process based on any other predetermined criteria. See at least 0030. OR, auction engine selects items for auction based on pre-determined criteria.
- First count of bids and first predetermined amount of time (i.e. first time interval): Originally filed claim 35 (canceled) discloses a first count of bids processed during a first predetermined amount of time (i.e. first time interval) in the context that the first count of bids, if less than or equal to a first predetermined number (value) automatically ends the auction. Note: A first predetermined value as claimed pertains to a first predetermined number of bids.

- Second count of bids and second predetermined amount of time (i.e. second time interval): For the case where the first count of bids is greater than the first predetermined number (value), the auction moves to a second predetermined amount of time (i.e. second time interval). The auction ends if a second count of bids processed during the second time interval is less than or equal that a second predetermined number of bids or when other predetermined criteria terminate the auction. Note: A second predetermined value as claimed pertains to a second predetermined number of bids.

Again, the supporting disclosure for the above claimed subject matter reads:

"In another embodiment, the determination of the end of bidding may be according to a tiered system that processes the received number of bids based upon one of a number of time increments. For example, the bidding may be ended if network device 106 receives five or less bids during the first twenty minutes, four or less bids during the next twenty minutes, and three or less bids during any twenty minute range beyond that."

Claims 35 and 36 originally filed provide subject matter not presently supported in the specification that establishes the proper context for the above disclosure for Step 285 of Figure 2, page 21, lines 3-10. As clarified by subject matter from claims 35 and 36, the auction ends after the first time increment because a first count of bids (e.g. five or less) was not greater than a first

predetermined number of bids (e.g. 5, 6, ...10, etc). The only way to move from the first time increment to the second time increment is for the first count of bids to be greater than the first predetermined number of bids (e.g. 5, 6, ...10 etc). The auction ends during the second time increment if the second count of bids (e.g. four or less) is not greater than a second predetermined number of bids (e.g. 4, 5, 6,10, etc).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claims 11, 41 and 53 and pending dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In light of the analysis under 35 USC 112, 1st paragraph above, all independent claims and their dependent claims are inoperative. From claim 11 for example,

“determining that the period of time has expired based on determining that:

- 1) a first quantity of bids that is received before a first time interval is less than a first pre-determined value; and

2) a second quantity of bids that is received before a second time interval is less than a second pre-determined value; and"

Both 1) and 2) are required for auction termination yet 2) cannot be a factor since 1) terminated the auction since the first quantity of bids is less than a first predetermined value. Lacking execution of 2), there is no tiered system of time increments in play.

An examination of the pending claims on their merit is not provided due to the inoperative nature of the current independent claims.

- 3. Claims 41, 42, 44, 50, 51, 53, 54, 56, 62 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As claimed, Applicants are attempting to incorporate subject matter of a method claim (e.g. claim 11) which itself incorporates another statutory class (i.e. computing apparatus of a server) into computer readable medium. Correction is required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert M. Pond/
Primary Examiner, Art Unit 3625
February 25, 2009